

REMARKS

Claims 1-22 and 24-39 were pending in the case, prior to the instant Office Action. Claims 24 and 25 were withdrawn from consideration, thus leaving claims 1-22, 26-31, and 32-39 under prosecution. On Page 2 of the instant Office Action, lines 3-4, it is stated that claims 32, 33, 36 and 37 are withdrawn from consideration. It is not clear to Applicants when these claims were withdrawn from consideration since they were added only in the Amendment of June 18, 2003 and were presented then following the Examiner's suggestions in the Office Action of May 5, 2003 and are still pending as Applicants' records indicate. Applicants believe claims 32, 33, 36 and 37 are still part of the claims under consideration. Correction accordingly is respectfully requested. Applicants would like to respectfully point out that the same request was made in Applicants' last Response of October 2, 2003. Thus, the following Remarks are being submitted for pending claims 1-22 and 32-39.

In the present Office Action, claims 27-31, 34, 35, 38 and 39 stand allowed, claims 1 and 21 stand rejected, and claims 2-20, 22 and 26 are objected to as being dependent on rejected claim(s). It is believed that claims 32, 33, 36 and 37 are still part of the claims under consideration.

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by *Shimada* (JP 7-228594). It is stated that *Shimada's* compound 8 on col. 13 anticipates claim 1. Applicants would like to respectfully point out that *Shimada's* compound, as the Examiner states correctly, has R¹ as -CO-NH-R¹⁰, which is a directly linked carboxamide. On the other hand, the present claim 1, as the amendment of October 2, 2003 shows, *excludes* a directly linked carboxylic acid, carboxylate ester and carboxamide for R¹. Thus, R¹ (from the amendment of October 2, 2003) is COR⁵ or B(OR)₂, wherein R⁵ = H, OH, OR⁸, NR⁹R¹⁰, CF₃, C₂F₅, C₃F₇, CF₂R⁶, R⁶, COR⁷ wherein R⁷ = H, OH, OR⁸, CHR⁹R¹⁰, or NR⁹R¹⁰. This makes R¹ to be possibly only CHO, COCF₃, COC₂F₅, COC₃F₇, COCF₂R⁶, COR⁶, COCOCHO, COCOOH, COCOOR⁸, COCOCHR⁹R¹⁰, COCONR⁹R¹⁰. None of these is the same as *Shimada's* R¹ which is -CO-NH-R¹⁰ (a directly linked carboxamide). Withdrawal of the §102 (b) rejection is, therefore, respectfully requested.

Claim 1 was also rejected under 35 U.S.C. §102(b) as being anticipated by *Dutta* (*J. Med. Chem.* 33, 2552 (1990)). It is stated that *Dutta's* compound 5 on page 2553 anticipates claim 1. Applicants would like to respectfully point out that *Dutta's* compound, as the Examiner states correctly, has R¹ as -CO-NH-R¹⁰, which is a directly linked carboxamide. On the other hand, as stated above and as the

amendment of October 2, 2003 shows, the present claim 1 *excludes* a directly linked carboxylic acid, carboxylate ester and carboxamide for R¹. Thus, R¹ (from the amendment of October 2, 2003) is COR⁵ or B(OR)₂, wherein R⁵ = H, OH, OR⁸, NR⁹R¹⁰, CF₃, C₂F₅, C₃F₇, CF₂R⁶, R⁶, COR⁷ wherein R⁷ = H, OH, OR⁸, CHR⁹R¹⁰, or NR⁹R¹⁰. This makes R¹ to be possibly only CHO, COCF₃, COC₂F₅, COC₃F₇, COCF₂R⁶, COR⁶, COCOCHO, COCOOH, COCOOR⁸, COCOCHR⁹R¹⁰, COCONR⁹R¹⁰. None of these is the same as *Dutta's* R¹ which is -CO-NH-R¹⁰ (a directly linked carboxamide). Withdrawal of the §102 (b) rejection is, therefore, respectfully requested.

Claim 21 was rejected under 35 U.S.C. §103 as being unpatentable over *Dutta* (*J. Med. Chem.* 33, 2552 (1990)). Since, as the prior-noted Remarks show, the compound of claim 1 is not the same as *Dutta's* compound 5, Applicants believe that this rejection is moot. Withdrawal of the §103 rejection is, therefore, respectfully requested.

There being no other rejections pending, Applicants believe that the claims, as amended, are in allowable condition and such an action is earnestly solicited. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,



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